

II. REMARKS

1. It is respectfully submitted that the combination of Moore and Von Kohorn does not establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) of claims 1-5, 10, 11, 15 and 17.

First, each element of claims 1-5, 10, 11, 15 and 17 is not disclosed or suggested by the combination of Moore and Von Kohorn. The Examiner admits that Moore does not disclose dispensing postal indicia using a television and a set-top box. The Examiner also admits that Moore does not disclose a customer requesting a postal indicium. In fact, Moore does not disclose or suggest a customer station as is claimed by Applicants. Moore is directed to a tracking system for tracking mailpiece as it travels through a mail system. It has nothing to do with ordering a postal indicia via a television as is claimed by Applicants.

In Moore, an identifiable mark is placed on the mailpiece to enable the subsequent inspection and tracking. (Col. 4, lines 25-27). Quite frankly, Moore is rather silent with regard to how the postal indicia is selected or made available as is the printing aspect, which is what Applicants' invention is directed to. For example, in Applicants' invention as recited in the preamble, it is stated that the invention comprise a "system for printing postal indicia at more than one location." Moore does not speak in any depth to the printing aspect, let alone printing "postal indicia" at more than one location.

Also, unlike Moore, in Applicants' invention, the ordering of postal indicia is initiated by the customer from the customer

location. For example, as recited in claim 1, the customer provides information for "ordering enhanced television services at the television." Nothing like this is disclosed or suggested by Moore. Moore does not speak to how the postal indicia might be ordered or purchased. Thus, Moore cannot disclose or suggest at least this aspect of Applicants' invention.

Moore also does not disclose a "host" as claimed by Applicants. In Moore, as shown with respect to FIG. 1, each "host customer" is associated with its own respective "PSD" 400'-400'". (See FIG. 1). This is unlike Applicants' invention. In Applicants' invention, referring for example to Fig. 1, a host data center 65 is shown that includes one or more PSD's 10A, 10B, and 10C. Thus the host in Moore is not the same as the host in Applicants' invention.

Moore, as noted by the Examiner, fails to disclose or suggest, "means responsive to information provided by the customer at the remote control at one of said customer stations for sending to the host a first message requesting a postal indicium and identifying the customer station associated therewith." Moore merely enables the marking systems to imprint indicia marks or mailpieces as specified. (Col. 14, lines 60-61). Thus, this feature of Applicants' invention is also not disclosed or suggested.

The accounting means taught by Moore is not the same as the accounting means disclosed by Applicants. In Applicants' invention as recited in claim 1, the accounting means in the host stores information indicative of postage value printed at each of the customer stations. This is not disclosed or suggested by Moore. In Moore, the control computer provides an "allotment" of marks "allotted" to the host computer. This "accounting" is

merely a "tracking" function and is not the same as storing information indicating postage value printed, as is claimed by Applicants.

The other function of the accounting system in Moore is to allot a prescribed number of marks to the marker and track the activity of the markers and count the marks made. (Col. 13, line 63 to Col. 14, line 4). This is still not the same as storing information indicative of postage value printed at each customer station and "means responsive to the message identifying the customer station for modifying the stored information associated with the customer station within said accounting means" as claimed by Applicants. Thus, Moore cannot disclose this feature of Applicants' invention.

Von Kohorn does not overcome the above-noted deficiencies of Moore. First, Von Kohorn has nothing to do with postal indicia. In Von Kohorn, only tokens and coupons are generated. (Abstract, lines 1-2). The tokens or coupons then need to be "redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value, and "redemption" at a "redemption facility" is not required. Furthermore, in Von Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicants' invention, the customer station requests the postal indicia, which is eventually communicated to the customer station. The postal indicia, when communicated has a "postage value" as recited in claim 1. Thus, this aspect of Applicants' invention is neither disclosed nor suggested by Von Kohorn, or the combination of Moore and Von Kohorn.

Furthermore, in Von Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Von Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicants' invention, the user initiates the request without such prompting. Thus, Von Kohorn does not disclose or suggest this feature of Applicants' invention. As noted above, Moore also does not disclose or suggest at least this feature, so the combination cannot as well.

Von Kohorn also does not disclose or suggest accounting means as recited by Applicants in claim 1. In Von Kohorn, as discussed above, the tokens or coupons have no value until they are presented for redemption at a redemption center. Von Kohorn does not disclose or suggest storing information indicative of postage "value" printed at a customer station as is claimed by Applicants. Moore, for the reasons stated above, does not disclose or suggest an accounting means as claimed by Applicants. Thus, the combination of Moore and Von Kohorn cannot as well.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, Moore in view of Von Kohorn does not disclose or suggest each feature of Applicants'

invention as claimed. Thus, a *prima facie* case of obviousness over Applicants' inventions cannot be established.

Applicants submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention, as recited in the claims, would be obvious over the combination of Moore and Von Kohorn is not supported by the factual contents of Moore and Von Kohorn. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the Moore and Von Kohorn references as proposed for purposes of 35 U.S.C. §103(a). Moore is directed to a tracking system and is not even remotely suggestive of ordering postal indicia via a television set top box. As mentioned earlier, Moore is substantially silent as to how the indicia ends up on the mailpiece other than suggesting that the host is provided with an "allotment" of marks. A person of skill, who did not have prior knowledge of Applicants' invention, would not be motivated to alter Moore to achieve Applicants' invention.

Von Kohorn also does not offer the requisite suggestion or motivation to modify Von Kohorn in view of Moore to achieve Applicant's invention. Von Kohorn is directed to coupons and tokens that have no value, unlike a postal indicia. There is not disclosure in Von Kohorn to printing a coupon with an associated value. Perhaps it can be said that with "hindsight" of Applicants' invention, one might be motivated to alter Moore in view of Von Kohorn to achieve Applicants' invention. However, the use of such hindsight is improper, and the suggestion or motivation to combine or modify the references must be found in

the references themselves. It is respectfully submitted that it is not.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness of claims 1-5, 10, 11, 15 and 17 of Applicants' invention, over Moore in view of Von Kohorn, under 35 U.S.C. §103(a) is not, and cannot be, established. These claims should therefore be allowable.

Furthermore, the Applicants respectfully note that Moore and Von Kohorn have been combined improperly for purposes of 35 U.S.C. §103(a). References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Moore and Von Kohorn are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Moore nor Von Kohorn are in the same field as the Applicants' invention. Moore is directed to a tracking system for tracking a mailpiece(s) as it travels through a mail system. It has nothing to do with ordering postal indicia via a television as is claimed by Applicants. In Moore, an identifiable mark is placed on the mailpiece to enable the

subsequent inspection and tracking. (Col. 4, lines 25-27). Moore is silent on ordering postal indicia, which is the subject of Applicants' invention. As recited in the specification, page 1, lines 2-4, the invention relates to the task of printing postage indicia, particularly with a set-top box or web television interface. Nothing in Moore is even remotely suggestive of this. Rather, as stated in Moore, it is an authenticating, anti-counterfeiting and tracking system. Moore has nothing to do with ordering postal indicia via a set-top box. Thus, Moore and Applicants' invention are not in the same fields of endeavor and are not directed to solving the same problem.

Similarly, Von Kohorn is not in the same field of endeavor as Applicants' invention and is not reasonably pertinent to the particular problem with which the Applicants were concerned. The Applicants were concerned with printing postal indicia on mailpieces and the ability to order or request postal indicia using a set-top box attached to a television set. Von Kohorn is not reasonably pertinent to that problem. Von Kohorn has nothing to do with postal indicia. In Von Kohorn, only tokens and coupons are generated. (Abstract, lines 1-2). The tokens or coupons then need to be "redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value, and "redemption" at a "redemption facility" is not required. Furthermore, in Von Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicants' invention, the customer station requests the postal indicia, which is eventually communicated to the customer station. The postal indicia, when communicated has a "postage value".

Furthermore, in Von Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Von Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicants' invention, the user initiates the request without such prompting. Thus, although Von Kohorn may use a set-top box to generate coupons or tokens, these coupons and tokens are nothing like postal indicia, and Von Kohorn does not even suggest that a secure transaction, which is needed for postal indicia generation, could take place.

Thus, Moore and Von Kohorn do not address the problems addressed by Applicants' invention, are not in the same field of endeavor as the Applicants' invention and are not reasonably pertinent to the particular problem with which the Applicants were concerned, Pursuant to the provisions of 35 U.S.C. §103(a), Moore and Von Kohorn are not analogous art and may not properly be combined to establish a *prima facie* case of obviousness. Claim 1 should thus be allowable.

Claims 2-4 should be allowable for similar reasons as stated above.

Claims 10, 11, 15 and 17 depend from claim 1 and should be allowable at least in view of the dependencies.

Claim 10 also recites that the postal security devices in the host are shared among the customers. No such teaching exists in Moore where each Host Customer has its own PSD (See FIG. 1). Von Kohorn does not teach the use of a PSD. The sharing of printers,

referred to by the Examiner, is not the same sharing postal security devices among customers. Thus, Moore in view of Von Kohorn cannot disclose or suggest this feature.

Claim 11 recites that the host maintains accounting information for each customer. This is not disclosed or suggested by either Moore or Von Kohorn. Including certain information in the mark is not the same as maintaining accounting information as claimed.

2. Claims 6-7 are not unpatentable over Moore in view of Von Kohorn in view of Bush under 35 U.S.C. §103(a) . Claims 6-7 should be allowable at least in view of their respective dependencies on claim 1.

Also, claim 6 recites that a postage submenu can be called up to allow the user to enter identification data associated with the request for postal indicia. Bush merely teaches presenting a user with payment options on a menu. Bush is not related to requesting postal indicia as claimed by Applicants. Thus, claim 6 is not unpatentable over the combination.

3. Claim 8 depends from claim 1, and for at least that reason should be allowable.

4. Claim 9 depends from claim 1 and should also be allowable at least in view of the dependency.

Furthermore, Reisinger et al. ("Reisinger") does not teach a weight scale coupled to a set top box. Rather, in Reisinger, the scale is coupled directly to the postage meter machine. The set top box of Applicants' invention is not the postage indicia generating device. Rather, in Applicants' invention, the mass information is transmitted from the weight scale **through the set-**

top box back to the host to determine the indicia. This is quite different from Reisinger.

The Examiner's proposed motivation to combine or modify the references is misplaced, since in Applicants' invention the weight scale is not attached directly to the postage indicia generating device. Thus, claim 9 is allowable.

5. Claims 12-14 and 16 are not unpatentable over Moore in view of Von Kohorn further in view of Merjanian under 35 U.S.C. §103(a). Claims 12-14 and 16 depend from claim 1 and should be allowable at least in view of the dependencies.

6. Claims 13, 14 and 16 are not unpatentable over Moore in view of Von Kohorn and further in view of Schwartz et al. ("Schwartz") and PriceWatch under 35 U.S.C. §103(a). Claims 13, 14 and 16 depend from claim 1 and should also be allowable at least in view of the respective dependencies. Schwartz is also assigned to the assignee of the instant application and may not be available as prior art pursuant to 35 U.S.C. §103(c). Furthermore, PriceWatch does not disclose or suggest that the host is "linked" to delivery service providers or that the information retrieved is related to the request. On PriceWatch the database is updated periodically. (page 2, first paragraph). Thus, price comparisons may not be accurate. (Third paragraph). This is not the same as Applicants' invention where the comparison information is retrieved in real-time.

Also, the Examiner incorrectly states that PriceWatch is the single point of contact between customers and service providers. (See, e.g., page 2, third and fourth paragraphs; see also, page 2, seventh paragraph where PriceWatch states their database is

limited.) This is not the case in Applicants' invention. Thus, these claims should be allowable.

7. Claims 18-20 are not unpatentable over Moore in view of Von Kohorn further in view of Schwartz, Brookner et al. ("Brookner") and PriceWatch. The same arguments related to establishing a *prima facie* case of obviousness using Moore and Von Kohorn are equally applicable here. Thus, it is respectfully submitted that Moore and Von Kohorn are not available here for purposes of 35 U.S.C. §103(a). Schwartz and PriceWatch are also deficient for the reasons stated in the paragraph above.

The Examiner has not stated in what context the Brookner reference is being applied here. Correction is requested. Brookner is also not proper art pursuant to 35 U.S.C. §103®, since Brookner and the instant application are both assigned to the same entity. Thus, claims 18-20 should also be allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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